

### REMARKS

This responds to the Office Action dated February 24, 2006.

Claims 1-36 remain pending in this application.

#### Information Disclosure Statement

Applicant submitted a Supplemental Information Disclosure Statement and a 1449 Form on November 23, 2004. Applicant respectfully requests that initialed copies of the 1449 forms be returned to Applicants' Representatives to indicate that the cited references have been considered by the Examiner.

#### §103 Rejection of the Claims

Claims 1, 2, 15-20, 29, 31 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over “Contak TR CHFD” System Guide (hereinafter “the System Guide”) in view of Stroebel et al. (U.S. Patent No. 5,725,561, hereinafter “Stroebel”).

Claims 3-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the System Guide in view of Stroebel.

Claims 28 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the System Guide in view of Stroebel.

#### *Claim 1*

Applicant respectfully traverses the rejection and submits that the System Guide and Stroebel, each alone or in combination, do not provide the recited subject matter. For example, Applicant is unable to find in the System Guide and Stroebel, each alone or in combination, among other things, a teaching or suggestion of a rate smoothing module configured to select a first rate smoothing percentage and a second rate smoothing percentage of a rate smoothing algorithm based on whether a predetermined state is present, as recited in claim 1. More specifically, Applicant is unable to find in the cited references any teaching or suggestion that their combination necessarily results in the selection of the “rate smoothing up” percentage based on whether the predetermined state is present.

The Office Action states, under Response to Arguments:

In addition, Stroebel does not specifically state that rate increase smoothing should not be used or should be used, but that the sudden rate increase does not “appear” to require smoothing. Therefore Stroebel does not teach against rate increase smoothing and leaves the door open to that possibility.

However, leaving “the door open for [a] possibility” is not a teaching or suggestion of including that possibility.

Additionally, Applicant respectfully submits that the Office Action has not set forth a proper *prima facie* case of obviousness. Pursuant to M.P.E.P. § 2143.01, the fact that references can be combined or modified does not render the resultant combination or modification obvious unless the prior art also suggests the desirability of the combination or modification. Applicant respectfully submits that the cited references do not suggest the desirability. For example, Applicant is unable to find in the System Guide or Stroebel, individually or in combination, a suggestion or motivation to modify the device of the System Guide to include the selection of both of its “rate smoothing up” and “rate smooth down” percentages based on whether a predetermined state is present.

Stroebel relates to “a rate smoothing capability to prevent large, sudden drop in pacing rate”. (Column 8, lines 1-3; see also column 2, line 62 to column 3, line 11). Stroebel states:

In general it is considered symptomatic for a patient to experience sudden rate drops so we smooth them. The contrary, sudden rate increase, does not appear to require smoothing.

(Column 8, lines 10-13). Then, the cited portions of Stroebel (column 9) discusses prevention of “abrupt downward adjustment in rate”, and “a pacing rate ‘floor’” below which the rate will be smoothed, in contrary to providing a motivation or suggestion to include a limit of pacing rate increase. Leaving “the door open for [a] possibility” is not a motivation or suggestion.

Therefore, Applicant respectfully submits that the proposed combination of references does not provide a proper basis for the obviousness rejection.

Applicant respectfully requests reconsideration and allowance of claim 1.

#### *Claims 2 and 15*

Applicant respectfully traverses the rejection of claims 2 and 15. Claims 2 and 15 are dependent on claim 1. Thus, the discussion above for claim 1 is incorporated herein to support the patentability of claims 2 and 15.

Applicant respectfully requests reconsideration and allowance of claims 2 and 15.

*Claim 16*

Applicant respectfully traverses the rejection and submits that the System Guide and Stroebel, each alone or in combination, do not teach or suggest the recited subject matter. For example, Applicant is unable to find in the System Guide and Stroebel, each alone or in combination, among other things, a teaching or suggestion of selecting a first rate smoothing percentage and a second rate smoothing percentage of a rate smoothing algorithm using an implantable system if the state of at least one of a cardiac signal and a physiologic parameter corresponds to a predetermined state, as recited in claim 16.

Because claims 1 and 16 are rejected on the same ground, the discussion above for claim 1 is incorporated herein to support the patentability of claim 16.

Applicant respectfully requests reconsideration and allowance of claim 16.

*Claims 17-20, 29, and 31*

Applicant respectfully traverses the rejection of claims 17-20, 29, and 31. Claims 17-20, 29, and 31 are dependent on claim 16. Thus, the discussion above for claim 16 is incorporated herein to support the patentability of claims 17-20, 29, and 31.

Applicant respectfully requests reconsideration and allowance of claims 17-20, 29, and 31.

*Claim 32*

Applicant respectfully traverses the rejection and submits that Boue and Stroebel, each alone or in combination, do not teach or suggest the recited subject matter. For example, Applicant is unable to find in System Guide and Stroebel, each alone or in combination, among other things, a teaching or suggestion of selecting a first rate smoothing percentage and a second rate smoothing percentage of a rate smoothing algorithm using an implantable system if the state of a cardiac signal corresponds to at least one predetermined heart rate state, as recited in claim 32.

Because claims 1 and 32 are rejected on the same ground, the discussion above for claim 1 is incorporated herein to support the patentability of claim 32.

Applicant respectfully requests reconsideration and allowance of claim 32.

*Claim 3-6*

Applicant respectfully traverses the rejection of claims 3-6. Claims 3-6 are dependent on claim 1. Thus, the discussion above for claim 1 is incorporated herein to support the patentability of claims 3-6.

Applicant respectfully requests reconsideration and allowance of claims 3-6.

*Claims 28 and 30*

Applicant respectfully traverses the rejection of claims 28 and 30. Claims 28 and 30 are dependent on claim 16. Thus, the discussion above for claim 16 is incorporated herein to support the patentability of claims 28 and 30.

Applicant respectfully requests reconsideration and allowance of claims 28 and 30.

*Reentry of Withdrawn Claims Requested*

Claims 7-14, 21-27, and 33-36 were withdrawn from consideration. In light of what is believed to be allowable as discussed above, Applicant respectfully requests reentry and consideration of claims 7-14, 21-27, and 33-36 in this application.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 373-6912 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By their Representatives,

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Date April 24, 2006

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 24 day of April, 2006.

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